

Appl. No. 10/054,749
Amdt. dated April 24, 2006
Reply to Office Action of October 24, 2005

PATENT

REMARKS/ARGUMENTS

Claims 1-66 were pending in this application. In the Office Action, the Examiner is unclear as to which claims the Applicants feel should benefit from priority. The Office Action rejected claims 23-44 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Office Action rejected claims 1-66 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,725,428 to Pareschi et al. Claims 23 and 35 have been amended. Claims 1-66 remain pending in this application after entry of this amendment. No new matter has been entered.

Priority Under 35 U.S.C. § 120

The Application claims priority from and is a continuation-in-part (CIP) application of U.S. Application No. 09/958,000, (Attorney Docket No. 15358-006700US) filed September 20, 2001. In the Office Action, the Examiner is unclear as to which claims Applicants feel should benefit from priority because the claims of the Application are "significantly" different from the claims of the priority document. The Office Action further requests that the Applicants clearly point to the limitations in the claims that seek priority.

Applicants submit that this Application properly claims priority to the priority documents such that all claims in the Application directed to subject matter disclosed in the priority document receive the effective filing date of the priority document. Furthermore, the Office Action cites U.S. Patent No. 6,725,428 to Pareschi et al. (hereinafter Pareschi) filed on November 14, 1997. The Application was filed on January 18, 2002 and claims priority to U.S. Application No. 09/958,000, (Attorney Docket No. 15358-006700US) filed September 20, 2001. Applicants are unclear as to the Examiner's reasoning when Pareschi was filed before the Application and the priority document. The information requested by the Examiner is not necessary in view of the Office Action.

Under 37 C.F.R. § 1.105, an Examiner or other Office employee may require from individuals identified under 37 C.F.R. § 1.56(c), or any assignee, the submission of such information as may be reasonably necessary to properly examine or treat a matter in a pending or

Appl. No. 10/054,749
Amdt. dated April 24, 2006
Reply to Office Action of October 24, 2005

PATENT

abandoned application. Applicants submit that the Office Action request is not reasonably necessary to properly examine the Application. It is a clear fact that Pareschi was filed before the Application and the priority document.

Applicants further submit that the claims in the Application should be different from the claims in the priority document. As stated in 37 C.F.R. § 1.141 two or more independent and distinct inventions may not be claimed in one national application. Applicants submit that the Office Actions fails to recite why the inclusion of different claims in the Application from the claims in the priority document affects an otherwise proper claim of priority.

Additionally, under 35 U.S.C. § 120, the claims in a U.S. application are entitled to the benefit of the filing date of an earlier filed U.S. application if the subject matter of the claim is disclosed in the manner provided by 35 U.S.C. § 112, first paragraph in the earlier filed application. 35 U.S.C. § 112, first paragraph, requires that the specification of the earlier filed U.S. application include the following: a written description of the invention, the manner and process of making and using the invention (the enablement requirement), and the best mode contemplated by the inventor of carrying out his invention. Applicants submit that the priority document meets all of the requirements set forth in 35 U.S.C. § 112, first paragraph.

First, the inquiry into whether the description requirement is met must be determined on a case-by-case basis and is a question of fact. *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the Examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The Examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The Examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. The Office Action alleges that the claims are "significantly" different from the claims in the priority document. Applicants submit that this reasoning does not meet the Examiner's burden of

Appl. No. 10/054,749
Amdt. dated April 24, 2006
Reply to Office Action of October 24, 2005

PATENT

presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims.

Next, once the Examiner has weighed all the evidence and established a reasonable basis to question the enablement provided for the claimed invention, then the burden falls on applicant to present persuasive arguments, supported by suitable proofs where necessary, that one skilled in the art would be able to make and use the claimed invention using the application as a guide. *In re Brandstadter*, 484 F.2d 1395, 1406-07, 179 USPQ 286, 294 (CCPA 1973). Again, the Office Action references the claims in the priority document. Applicants submit that the Office Action has not established nor articulated a reasonable basis to question the enablement provided for the claimed invention.

Finally, determining compliance with the best mode requirement requires a two-prong inquiry. First, it must be determined whether, at the time the application was filed, the inventor possessed a best mode for practicing the invention. This is a subjective inquiry which focuses on the inventor's state of mind at the time of filing. Second, if the inventor did possess a best mode, it must be determined whether the written description disclosed the best mode such that a person skilled in the art could practice it. This is an objective inquiry, focusing on the scope of the claimed invention and the level of skill in the art. *Eli Lilly & Co. v. Barr Laboratories Inc.*, 251 F.3d 955, 963, 58 USPQ2d 1865, 1874 (Fed. Cir. 2001). Applicants submit that the Office Action has not established or articulated any failure on the part of the Application or the priority document to meet this requirement.

In light of the above, Applicants submit that the priority document supports the corresponding claims that recited subject matter disclosed in the priority document. Thus Applicants, submit that the Application properly claims priority from and is a continuation-in-part (CIP) application of U.S. Application No. 09/958,000, (Attorney Docket No. 15358-006700US) filed September 20, 2001.

Appl. No. 10/054,749
Amdt. dated April 24, 2006
Reply to Office Action of October 24, 2005

PATENT

Claim Rejections Under 35 U.S.C. § 101

The Office Action rejected claims 23-44 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Office Action alleges that the corresponding claims do not clearly define the claimed invention as a tangible embodiment and therefore the claims are non-statutory. Applicants respectfully traverse the rejections and request reconsideration and withdrawal of the rejections.

The Office Action points to M.P.E.P. § 2105 entitled "Patentable Subject Matter - Living Subject Matter" to provide a basis for the rejection. However, Applicants point the Examiner's attention to the guidelines in M.P.E.P. § 2106 entitled "Patentable Subject Matter - Computer-Related Inventions" as better assisting the Examiner in such a determination.

M.P.E.P. § 2106 IV.B.1 states in part:

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

Applicants submit that the computer program product stored on a computer readable storage medium as recited in claims 23-44 is statutory subject matter under 35 U.S.C. § 101. Applicants further submit that the amendment suggested in the Office Action is unnecessary given the Federal Circuits interpretation of 35 U.S.C. § 101 as applied to articles of manufacture in computer related inventions.

The Office Action suggests including the limitation "contained on a tangible embodied computer readable medium" to overcome this rejection. However, the language of this proposed amendment makes no sense. Applicants, however, have included the word tangible in claims 23 and 35 to recite "a tangible computer readable storage medium." Thus, Applicants respectfully submit that claims 23-44 recite statutory subject matter under 35 U.S.C. § 101.

Appl. No. 10/054,749
Amdt. dated April 24, 2006
Reply to Office Action of October 24, 2005

PATENT

Claim Rejections Under 35 U.S.C. § 102(e)

The Office Action rejected claims 1-66 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,725,428 to Pareschi et al. (hereinafter Pareschi). The Office Action alleges that Pareschi teaches or suggests all of the claimed limitations of the corresponding claims. Applicants respectfully traverse the rejections and request reconsideration and withdrawal of the rejections based on Pareschi.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Applicants respectfully contend that Pareschi fails to disclose all of the claimed limitations recited in each of claims 1-66.

Claim 1

Claim 1 recites a method of processing a document in a workflow system. As recited in claim 1, the method includes detecting when a document is at a refinable place in a first workflow network, the first workflow network specifying a plurality of operations to be performed on the document including a first operation and a second operation, the refinable place occurring at a location in the first workflow network after the first operation and before the second operation is performed on the document. As further recited in claim 1, the method includes determining, when the document is at the refinable place, if a second workflow network specified by the document is permitted to be attached to the refinable place of the first workflow network, the second workflow network specifying one or more operations to be performed on the document. As recited in claim 1, the method includes if the second workflow network specified by the document is permitted to be attached to the refinable place of the first workflow network, attaching the second workflow network to the refinable place of the first workflow network such that the document is processed according to the second workflow network before the second operation specified by the first workflow network is performed on the document.

Appl. No. 10/054,749
Amdt. dated April 24, 2006
Reply to Office Action of October 24, 2005

PATENT

According to the teachings of the present invention, a Petri net representing an active document workflow comprises at least one refinable place. Applicants' FIG. 2A represents a refinable place by a double circle. (Application: FIG. 2A; Reference 202). The "refinable place" in a Petri net representing an active document workflow represents a place in the net that can be refined or modified based upon control information associated with a document processed by the workflow. More specifically, according to an embodiment of the present invention, a refinable place in a first Petri net representing a first workflow corresponds to a node in the first net where a second Petri network representing a second workflow can be attached. (Application: Paragraph [32]):

The process of attaching the second Petri network to the refinable space in the first Petri net is also referred to as "refinement" of the refinable place in the first Petri net. The second Petri net is referred to as a "refinement net" and the first Petri net is referred to as the "target net." Since a refinement network may specify one or more tasks and places (including one or more refinable places), refinement refers to the process of adding extra tasks to a target workflow process based upon control information associated with a document processed by the target workflow. Attaching a refinement Petri net to a refinable place of a target Petri net implies that when a document processed by a workflow represented by the target Petri net enters a place in the target workflow designated as the refinable place, the document is then routed and processed according to the workflow represented by the refinement net before the document is returned to the target workflow for further processing.

Applicants submit that these features as recited in claim 1 are not taught or suggested by Pareschi.

(a) Detecting a refinable place in a first workflow network

The Office Action alleges that FIG. 4, FIG. 12, and Col. 10, lines 36-46 disclose detecting when a document is at a refinable place in a first workflow network, the first workflow network specifying a plurality of operations to be performed on the document including a first operation and a second operation, the refinable place occurring at a location in the first workflow

Appl. No. 10/054,749
Amdt. dated April 24, 2006
Reply to Office Action of October 24, 2005

PATENT

network after the first operation and before the second operation is performed on the document. Applicants respectfully disagree.

Applicants submit that Pareschi does not teach or suggest a refinable place as recited in claim 1. FIG. 4 shows the allowed transitions between one activity state to another and between one document state to another, and loosely indicates how transitions in each state are coupled. Pareschi separates activity states that point to a document from document states that point to an activity providing activity-triggered processes or document-triggered processes. (Pareschi: Col. 7, lines 26-32 and lines 34-49). However, separating activity states from document states does not teach or suggest detecting when a document is at a refinable place as recited in claim 1. As discussed above, a "refinable place" in a Petri net representing an active document workflow represents a place in the net that can be refined or modified based upon control information associated with a document processed by the workflow. In contrast, FIG. 4 of Pareschi shows activity states and document states that do not involve modification and are therefore not refinable as recited in claim 1.

Furthermore, Col. 10, lines 36-46 disclose co-ordination of solutions for non-decomposable documents. FIG. 12 discloses a document view of an authoring processes shown by the generalized process structure grammars in FIG 8A and FIG. 8B. FIG. 12 also discloses the sequential activities and concurrent activities of the non-decomposable document process discussed in Col. 10, lines 36-46. (Pareschi: Col. 11, lines 24-38). Applicants submit that the sequential and concurrent activities of the non-decomposable document process in Pareschi are not the refinable place recited in claim 1.

In Pareschi, decomposable document processes are where process tasks map one-to-one onto the independent sections of a decomposable document. An example of such a process might be the writing of a book in the case where it can be broken down into almost independent sections such as the introduction, chapters, and conclusion. In the second case of non-decomposable document processes, there will be a many-to-one mapping of documents to tasks and tasks to documents. An example is the brainstorming, authoring, editing, and approval of a proposal, in which all steps of the process act upon the same physical document. There are two distinct co-ordination solutions for processes that require the sharing of a non-decomposable

Appl. No. 10/054,749
Amdt. dated April 24, 2006
Reply to Office Action of October 24, 2005

PATENT

document: (1) sequential activities, where each actor works on a locked version of the shared document; and (2) concurrent activities, where the work of actors upon a frozen version is later merged.

However, recited in claim 1, the refinable place refers to a place for adding extra tasks to a target workflow process based upon control information associated with a document processed by the target workflow. As discussed above, attaching a refinement Petri net to a refinable place of a target Petri net implies that when a document processed by a workflow represented by the target Petri net enters a place in the target workflow designated as the refinable place, the document is then routed and processed according to the workflow represented by the refinement net before the document is returned to the refinable place in the target workflow for further processing. In contrast, FIG. 12 shows an authoring process that does not involve modification to the process. Moreover, in FIG. 12, a parallel activity leaves the sequential activity and proceeds along a parallel path to return to the process at a different step in the process. Therefore, FIG. 12 does not teach or suggest the refinable placed recited in claim 1.

Thus, Applicants submit that Pareschi does not teach or suggest detecting when a document is at a refinable place in a first workflow network, or the first workflow network specifying a plurality of operations to be performed on the document including a first operation and a second operation, or the refinable place occurring at a location in the first workflow network after the first operation and before the second operation is performed on the document as recited in claim 1.

(b) Determining if a second workflow network is permitted to be attached to the refinable place of the first workflow network

The Office Action alleges that Col. 10, lines 36-46 and Col. 11, lines 24-38 disclose determining, when the document is at the refinable place, if a second workflow network specified by the document is permitted to be attached to the refinable place of the first workflow network, the second workflow network specifying one or more operations to be performed on the document. Applicants respectfully disagree.

Appl. No. 10/054,749
Amdt. dated April 24, 2006
Reply to Office Action of October 24, 2005

PATENT

As discussed above, Col. 10, lines 36-46 disclose sequential and concurrent activities for non-decomposable document processes. This does not teach or suggest a refinable place as recited in claim 1. Moreover, the sequential and concurrent activities do not involve determining whether the workflow process is the refinable place recited in claim 1. Therefore, the sequential and concurrent activities do not teach or suggest determining if a second workflow network is permitted to be attached to the refinable place of the first workflow network as recited in claim 1.

Furthermore, Col. 11, lines 24-38 discloses that the decomposability of a document may change over time and that this is shown in FIG. 12. As discussed above, making the shift between sequential and concurrent activities does not teach or suggest a refinable place and determining if a second workflow network is permitted to be attached to the refinable place of the first workflow network as recited in claim 1.

Thus, Applicants submit that Pareschi does not teach or suggest determining, when the document is at the refinable place, if a second workflow network specified by the document is permitted to be attached to the refinable place of the first workflow network, the second workflow network specifying one or more operations to be performed on the document as recited in claim 1.

(c) Attaching the second workflow network to the refinable place of the first workflow network

The Office action alleges that Col. 10, lines 36-46 and Col. 11, lines 24-38 discloses if the second workflow network specified by the document is permitted to be attached to the refinable place of the first workflow network, attaching the second workflow network to the refinable place of the first workflow network such that the document is processed according to the second workflow network before the second operation specified by the first workflow network is performed on the document. Applicants respectfully disagree.

As discussed above, Pareschi does not teach or suggest a refinable place as recited in claim 1. Furthermore, the sequential and concurrent activities disclosed in Col. 10, lines 36-

Appl. No. 10/054,749
Amdt. dated April 24, 2006
Reply to Office Action of October 24, 2005

PATENT

46 and Col. 11, lines 24-38 do not teach or suggest permitting a second workflow network to be attached as recited in claim 1.

In contrast to Pareschi, as discussed above, the refinable place recited in claim 1 allows attachment of a second workflow network with additional tasks to a first workflow network. When the additional tasks of the second workflow network are complete, the workflow processed resumes at the refinable place in the first workflow network. This feature is not taught or suggested in Pareschi. Therefore, Pareschi does not teach or suggest if the second workflow network specified by the document is permitted to be attached to the refinable place of the first workflow network, attaching the second workflow network to the refinable place of the first workflow network such that the document is processed according to the second workflow network before the second operation specified by the first workflow network is performed on the document as recited in claim 1.

In light of the above, Applicants submit that Pareschi fails to teach or suggest all of the claimed limitations of claim 1. Thus, Applicants respectfully submit that claim 1 is allowable.

Claims 2-66

Applicants submit that independent claims 13, 23, 35, 45, and 57 are allowable for a similar rationale as discussed above for the allowability of claim 1. Applicants submit that dependent claims 2-12, 14-22, 23-34, 36-44, 46-56, and 68-66 which depend on independent claims 13, 23, 35, 45, and 57 respectively, are allowable for at least a similar rationale as discussed above for the allowability of claims 1, 13, 23, 35, 45, and 57. Applicants further submit that the dependent claims are allowable for additional reasons.

Appl. No. 10/054,749
Amdt. dated April 24, 2006
Reply to Office Action of October 24, 2005

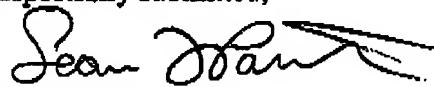
PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



Sean F. Parmenter
Reg. No. 53,437

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 650-326-2422
SFP:am
60740254 v1